

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Stephen P.A. Fodor, Lubert Stryer, J. Leighton Read and Michael C. Pirrung
Application No.: 10/033,195 Group Art Unit: 1637
Filed: December 28, 2001 Examiner: Riley, Jezia
Confirmation No.: 7969
Title: NUCLEOTIDES AND ANALOGS HAVING PHOTOREMOVABLE PROTECTING GROUPS

CERTIFICATE OF MAILING OR TRANSMISSION

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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Information Disclosure Statement is submitted:

[] under 37 CFR 1.129(a), or
(First/Second submission after Final Rejection)

[X] under 37 CFR 1.97(b), or

(Within any one of the following time periods: three months of filing national application (other than a CPA) or date of entry of the national stage in an international application; or before the mailing date of a first office action on the merits in a non-provisional application, including a CPA, or a Request for Continued Examination).

[] under 37 CFR 1.97(c) together with either:

[] a Statement under 37 CFR 1.97(e), as checked below, or

[] a \$180.00 fee under 37 CFR 1.17(p), or

(After the 37 CFR 1.97(b) time period, but before final action or notice of allowance, whichever occurs first)

[] under 37 CFR 1.97(d) together with:

[] a Statement under 37 CFR 1.97(e), as checked below, and

[] a \$180.00 fee under 37 CFR 1.17(p), or

(Filed after final action or notice of allowance, whichever occurs first, but on or before payment of the issue fee)

[] under 37 CFR 1.97(i):

Applicant requests that the IDS and cited reference(s) be placed in the application filewrapper.

(Filed after payment of issue fee)

Statement Under 37 CFR 1.97(e)

- [] Each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement; or
- [] No item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned, after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

Statement Under 37 CFR 1.704(d) (Patent Term Adjustment)

Applies to original applications (other than design) filed on or after May 29, 2000

- [] Each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the Information Disclosure Statement.

[X] Enclosed herewith is form PTO-1449:

[X] Copies of the cited references are enclosed.

[] Since this application was filed after June 30, 2003, copies of issued U.S. patents and published U.S. applications are not required and are not being provided.

[] Copies of the cited references are enclosed except those entered in prior application, U.S. Application No. [], to which priority under 35 U.S.C. 120 is claimed. [The earlier application contains copies of the cited references.]

[] The listed references were cited in the enclosed International Search Report in a counterpart foreign application.

[] The "concise explanation" requirement (non-English references) for reference(s) [] under 37 CFR 1.98(a)(3) is satisfied by:

[] the explanation provided on the attached sheet.

[] the explanation provided in the Specification.

[] submission of the enclosed International Search Report.

[] submission of the enclosed English-language version of a foreign Search Report and/or foreign Office Action.

[] the enclosed English language abstract.

[] Applicant requests that the following non-published pending applications be considered:

Examiner's
Initials

____ U.S. Patent Application No. [], by [inventor(s)], filed [], Docket No.: []

____ U.S. Patent Application No. [], by [inventor(s)], filed [], Docket No.: []

____ U.S. Patent Application No. [], by [inventor(s)], filed [], Docket No.: []

____ Examiner

____ Date

[] A copy of each above-cited application, including the current claims, is enclosed.

[] A copy of each above-cited application, including the current claims, is enclosed, except those entered in prior application, U.S. Application No. [], to which priority under 35 U.S.C. 120 is claimed.

The Examiner is requested to return a copy of the above list of pending applications indicating which references were considered with the next office communication.

It is requested that the information disclosed herein be made of record in this application.

Method of payment:

[] A check for the fee noted above is enclosed, or the fee has been included in the check with the accompanying Reply. A copy of this Statement is enclosed.

[] Please charge Deposit Account 08-0380 in the amount of \$[]. A copy of this Statement is enclosed.

[X] Please charge any deficiency in fees and credit any overpayment to Deposit Account 08-0380.

REMARKS

Applicants are providing the Examiner with an update of inter party matters that relate to the present application. Two commonly owned patents (US 5,744,305 and US 5,800,992) have been involved in interference proceedings. Specifically, the interferences were Interference No. 104,359 between commonly owned US 5,744,305 and Brown *et al.*, USSN 08/688,488, and Interference No. 104,358 between commonly owned US 5,800,992 and USSN 08/514,875. Both interferences were decided by the U.S. Patent Office in favor of the real party in interest, Affymetrix, Inc., the assignee of the present application. The losing party, Stanford, appealed to the US District Court for the Northern District of California where the case has been decided (Case # C99-21JF). In Interference No. 104,359, the District Court for the Northern District of California found that there was no interference, and the

matter was remanded back to the U.S. Patent Office. The validity of US 5,744,305 was upheld by the court. Interference No. 104,358 was dismissed in view of the outcome of the litigation discussed below.

Further, US 5,744,305 and US 5,800,992 were the subject of litigation (*Affymetrix, Inc. v. Hyseq, Inc.*, US District Court for the Northern District of California, San Francisco Division, Civil Action No. C98-03192 FMS, and *Affymerix. v. Syteni, Inc. and Incyte Pharmaceuticals, Inc.*, US District Court for the Northern District of California, San Francisco, Case No. C98-4508 FMS (MEJ)). US 5,800,992 was held to be invalid under 35 U.S.C. § 112, first and second paragraphs, for lack of written description and indefiniteness. The validity of US 5,744,305 was upheld by the court.

Interference No. 105,089 between commonly owned USSN 09/614,068 and US 5,922,534 and US 6,255,053, assigned to Agilent Technologies, Inc., was recently terminated. All claims of US 5,922,534 and US 6,255,053 were held to be unpatentable. The claims of USSN 09/614,068, which were copied from the two patents, were also held to be unpatentable.

The references cited on the Form PTO-1449 and enclosed herewith were submitted as exhibits in Interference No. 105,089. Although some or all of the references may not be relevant to the pending claims, they are being cited to the Examiner in an abundance of caution.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By _____

N. Scott Pierce
Registration No.: 34,900
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: 11/2/04

PTO-1449 REPRODUCED

**SUPPLEMENTAL
INFORMATION DISCLOSURE
CITATION IN AN APPLICATION**

November 2, 2004
(Use several sheets if necessary)

ATTORNEY DOCKET NO.
2719.2002-001APPLICATION NO.
10/033,195FIRST NAMED INVENTOR
Stephen P.A. FodorFILING DATE
December 28, 2001EXAMINER
Riley, JeziaCONFIRMATION NO.
7969GROUP
1637**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL	REF. NO.	DOCUMENT NUMBER Number-Kind Code (if known)	ISSUE DATE / PUBLICATION DATE MM-DD-YYYY	NAME OF PATENTEE OR APPLICANT OF CITED DOCUMENT
	ZR	5,837,832	11-17-1998	Chee <i>et al.</i>
	ZS	3,642,450	02-15-1972	Eriksson
	ZT	5,688,642	11-18-1997	Chrisey <i>et al.</i>
	ZU	6,210,894 B1	04-03-2001	Brennan
	ZV	6,255,053 B1	07-03-2001	Lichtenwalter
	ZW	5,922,534	07-13-1999	Lichtenwalter
	ZX	4,996,142	02-26-1991	Al-Hakim <i>et al.</i>
	ZY	6,171,797 B1	01-09-2001	Perbost
	ZZ	6,221,653 B1	04-24-2001	Caren <i>et al.</i>
	AA2	6,235,483 B1	05-22-2001	Wolber <i>et al.</i>
	AB2	6,346,423 B1	02-12-2002	Schembri
	AC2	6,458,583 B1	10-01-2002	Bruhn <i>et al.</i>
	AD2	5,412,087	05-02-1995	McGall <i>et al.</i>
	AE2	4,591,570	05-27-1986	Chang
	AF2	4,563,417	01-07-1986	Albarella <i>et al.</i>

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER Country Code-Number-Kind Code (if known)	DATE MM-DD-YYYY	NAME OF PATENTEE OR APPLICANT OF CITED DOCUMENT	TRANSLATION YES NO
	AG2	WO 93/22680	11-11-1993	Affymax Technologies N.V.	

EXAMINER

DATE CONSIDERED

PTO-1449 REPRODUCED		ATTORNEY DOCKET NO. 2719.2002-001	APPLICATION NO. 10/033,195
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT IN AN APPLICATION November 2, 2004 (Use several sheets if necessary)		FIRST NAMED INVENTOR Stephen P.A. Fodor	FILING DATE December 28, 2001
		EXAMINER Riley, Jezia	CONFIRMATION NO. 7969
			GROUP 1637

NOV 05 2004
CIPR
PATENT & TRADEMARK OFFICE

OTHER DOCUMENTS (*Including Author, Title, Date, Pertinent Pages, Etc.*)

AH2	Southern, E.M., <i>et al.</i> , "Analyzing and Comparing Nucleic Acid Sequences by Hybridization to Arrays of Oligonucleotides: Evaluation Using Experimental Models, <i>Genomics</i> , 13: 1008-1017 (1992).
AI2	Maskos, U., and Southern, E.M., "Parallel Analysis of Oligodeoxyribonucleotide (oligonucleotide) Interactions. I. Analysis of Factors Influencing Oligonucleotide Duplex Formation, <i>Nucleic Acids Research</i> , 20(7): 1675-1678 (1992).
AJ2	Chrisey, L.A., <i>et al.</i> , "Selective Attachment of Synthetic DNA to Self-Assembled-Monolayer Functionalized Surfaces, <i>Mat. Res. Soc. Symp. Proc.</i> , 330: 179-184 (Symposium held Nov. 29-Dec. 3, 1993).
AK2	Southern, E.M., <i>et al.</i> , "Arrays of Complementary Oligonucleotides for Analysing the Hybridisation Behaviour of Nucleic Acids, <i>Nucleic Acids Research</i> , 22(8): 1368-1373 (1994).
AL2	Lamture, J.B., <i>et al.</i> , "Direct Detection of Nucleic Acid Hybridization on the Surface of a Charge Coupled Device, <i>Nucleic Acids Research</i> , 22(11): 2121-2125 (1994).
AM2	Guo, Z., <i>et al.</i> , "Direct Fluorescence Analysis of Genetic Polymorphisms by Hybridization with Oligonucleotide Arrays on Glass Supports, <i>Nucleic Acids Research</i> , 22(24): 5456-5465 (1994).
AN2	Eggers, M., <i>et al.</i> , "A Microchip for Quantitative Detection of Molecules Utilizing Luminescent and Radioisotope Reporter Groups, <i>BioTechniques</i> , 17(3): 516-524 (1994).
AO2	Wetmer, J.G., "Light-Directed, Spatially Addressable Parallel Chemical Synthesis," <i>Chemtracts-Biochem Mol. Biol.</i> , 2: 207-210 (1991).
AP2	Chow, T., <i>et al.</i> , "A High Capacity, Reusable Oligodeoxythimidine Affinity Column, <i>Analytical Biochemistry</i> , 175: 63-66 (1988).
AQ2	Dunn, A.R., and Sambrook, J., "Mapping Viral mRNAs by Sandwich Hybridization, <i>Methods in Enzymology</i> , 65: 468-478 (1980).
AR2	Weetall, H.H., "Covalent Coupling Methods for Inorganic Support Materials, <i>Methods in Enzymology</i> , 44: 134-148 (1976).
AS2	Rentrop, M., <i>et al.</i> , "Aminoalkylsilane-treated Glass Slides as Support for <i>in situ</i> Hybridization of Keratin cDNAs to Frozen Tissue Sections Under Varying Fixation and Pretreatment Conditions, <i>Histochemical Journal</i> , 18: 271-276 (1986).

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DATE CONSIDERED

PTO-1449 REPRODUCED		ATTORNEY DOCKET NO. 2719.2002-001	APPLICATION NO. 10/033,195	
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT IN AN APPLICATION		FIRST NAMED INVENTOR Stephen P.A. Fodor	FILING DATE December 28, 2001	
November 2, 2004 <i>(Use several sheets if necessary)</i>		EXAMINER Riley, Jezia	CONFIRMATION NO. 7969	GROUP 1637

*O I P E JC
NOV 05 2004
PATENT & TRADEMARK OFFICE*

OTHER DOCUMENTS (*Including Author, Title, Date, Pertinent Pages, Etc.*)

AT2	Matteucci, M.D. and Caruthers, M.H., "Synthesis of Deoxyoligonucleotides on a Polymer Support, <i>J. Am. Chem. Soc.</i> , 103: 3185-3191 (1981).
AU2	Kessler, "Nonradioactive Labeling Methods for Nucleic Acids," <i>Nonisotopic DNA Probe Techniques</i> , edited by Larry Kricka, Chapter 2, pp. 29-92 (1991).
AV2	Dyson, N.J., "Immobilization of Nucleic Acids and Hybridization Analysis," <i>Essential Molecular Biology Volume II: A Practical Approach</i> , edited by T.A. Brown, Chapter 5, pp. 111-156 (1991).

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